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10/789,469

02/27/2004

Uwe Nigrin

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11/27/2007

BAKER BOTTS L.L.P.

PATENT DEPARTMENT

98 SAN JACINTO BLVD., SUITE 1500

AUSTIN, TX 78701-4039

EXAMINER

TRIEU, THERESA

ART UNIT

PAPER NUMBER

3748

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/789,469

Applicant(s)

NIGRIN, UWE

Examiner

Theresa Trieu

Art Unit

3748

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Aug. 31, 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Feb. 27, 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

This Office Action is responsive to the applicants' amendment filed on Aug. 31, 2007.

Claims 1-14 are pending in this application.

#### *Drawings*

1. Applicants are required to shade the *rotor, vanes, cam ring, side plate, pump casing* with the shading scheme with represents a *plastic* (see claims 1, 4, 5, 11 and 12) (see MPEP §608.02).

#### *Claim Objections*

2. Claims 1, 4, 5, 11 and 12 are objected to, in that their subject matter needs to be incorporated into the specification and the drawings.

#### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 6, 8, 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taguchi (Publication Number JP 62-000684).

Regarding claims 1, 2, 6, 8, 9 and 13, Taguchi discloses a vane cell pump for delivering fluids, comprising a rotor 14, a cam ring 11 and a plurality of vanes 19 which are pre-tensioned by means of spring elements 17, 18, the spring elements 17, 18 being an integral part of the rotor 14, the spring elements are captively molded into the rotor; the spring elements being

implemented as spiral spring 23. However, Taguchi fails to disclose the rotor being made of plastic being designated as duroplast.

It is examiner's position that one having ordinary skill in the vane cell pump art, would have found it obvious to utilize the plastic rotor, since they are merely design parameters, depending on temperature, pressure, or stress acted/applied on the rotor or depending on being used for a particular purpose or solving a stated problem. Moreover, there is nothing in the record which establishes that the claimed plastic rotor under such conditions, presents a novel of unexpected result (See *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975)). Also, the applicant should note that the selection of a known material based upon its suitability for the intended use is a design choice consideration within the skill of the art. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

4. Claims 1-4, 6, 8-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Udono et al. (Udono) (Publication Number JP 56-151296).

Regarding claims 1, 6, 8 and 13, Udono discloses a vane cell pump for delivering fluids, comprising a rotor 3, a cam ring 5 and a plurality of vanes 2 which are pre-tensioned by means of spring elements 23-25 the spring elements 23-25 being an integral part of the rotor 3, the spring elements are captively molded into the rotor. However, Taguchi fails to disclose the rotor being made of plastic being designated as duroplast.

It is examiner's position that one having ordinary skill in the vane cell pump art would have found it obvious to utilize the plastic rotor, since they are merely design parameters, depending on temperature, pressure, or stress acted/applied on the rotor or depending on being used for a particular purpose or solving a stated problem. Moreover, there is nothing in the

record which establishes that the claimed plastic rotor under such conditions, presents a novel of unexpected result (See *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975)). Also, the applicant should note that the selection of a know material based upon its suitability for the intended use is a design choice consideration within the skill of the art. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

Regarding claims 2-4 and 9-11, Udonon discloses the spring elements are implemented as spring tongues 25; the spring elements being disposed on a ring 24; the spring elements being made of spring plastic.

5. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Udonon in view of design choice.

Udonon discloses the invention as recited above; however, Udonon fails to disclose the vanes and/or the cam ring and/or a side plate and/or a pump casing being made of plastic. It is examiner's position that one having ordinary skill in the vane cell pump art would have found it obvious to utilize the material being plastic, since they are merely design parameters, depending on temperature, pressure, or stress acted/applied on the rotor or depending on being used for a particular purpose or solving a stated problem.

6. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Udonon in view of design choice as applied to claim 1 and 8 above, and further in view of Grossner (Publication Number DE 1005007602).

The modified Udonon discloses the invention as recited above; however, the modified Udonon fails to disclose the vane pump being used as a pre-supply pump for a high-pressure pump of a common rail injection system.

It is examiner's position that one having ordinary skill in the vane cell pump art, would have found it obvious to utilize vane pump being used as supplying fluids, since they are merely design parameters, depending on being used for a particular purpose or solving a stated problem. Moreover, there is nothing in the record which establishes that the claimed vane cell pump for supplying fluid under such conditions, presents a novel of unexpected result (See *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975)).

### ***Response to Arguments***

7. Applicant's arguments filed on Aug. 31, 2007 have been fully considered but they are not persuasive.

- With regard to applicant's argument the Figures do not need to be amended as rotor, vanes, cam ring, side plate and pump casing having a shading scheme with represents a plastic. The examiner respectfully disagrees with this position.

Applicant notes that the rule 1.83 (a) state: "The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box)" (see MPEP, Patent Rule §1.83(a)). Accordingly, the objection to the drawing is maintained as set forth above.

- With regard to applicant's arguments on page 4 that Taguchi '684 or Udonon '296 does not teach or suggest the feature of "the spring elements are captively molded into the rotor". The examiner respectfully disagrees.

In response to applicant's argument that "to captively mold the spring elements into the rotor", a recitation of the product by process claim which is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon the applicants to come forward with evidence establishing an unobvious difference between the two. See *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983)

Applicant also notes that the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art.

- Regarding the 35 U.S.C. 103(a) rejection, applicant also asserts that the examiner has not established a prima facie case of obviousness since Taguchi '684 or Udonon '296 does not teach all of the claimed limitations recited in the claims. See the Remarks section, pages 3-4. The examiner is respectfully traversed.

On the contrary, as stated above, the Taguchi '684 or Udonon '296 reference does anticipate the invention as claimed since it teaches all of the claimed limitations. Thus, the prima facie case of obviousness has been established and claims 1-14 are remained rejected as discussed above.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theresa Trieu whose telephone number is 571-272-4868. The examiner can normally be reached on Monday-Friday 8:30am- 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas E. Denion can be reached on 571-272-4859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.




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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TT  
November 26, 2007



Theresa Trieu  
Primary Examiner  
Art Unit 3748